

Customer No. 09763589

Attorney Docket No. 2048-3-02

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Hyoung Chan Rhee, et al.

Serial No: 09/763,589

Filed: February 23, 2001

For: METHOD AND DEVICE FOR GENERATING
VOICE TEXT IMAGE COMMERCIAL
INFORMATION RINGBACK TONE DURING
COMMUNICATION WAIT

Art Unit: 2642

Examiner: B. Q. Tieu

I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450, on

May 12 2004

Date of Deposit

Amit Sheth

Name

Amit Sheth 05/12/2004

Signature

Date

PETITION AND FEE TO VOID ASSIGNMENT

Mail Stop Petition

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

RECEIVED

MAY 20 2004

Technology Center 2600

Dear Sir:

In accordance with MPEP § 1002.02(b), Applicants respectfully petition to void and nullify the assignment of the above referenced application, which was recorded on Reel 013739, Frame 0194 (copy enclosed). In addition to or in the alternative, Applicants respectfully request to void and nullify the assignment recorded on Reel 013630, Frame 0427 (copy enclosed), which also refers to the above referenced application.

The assignment recorded on Reel 013630, Frame 0427 (hereinafter referred to as "the Initial Assignment") was recorded on January 7, 2003. The assignors in the Initial Assignment are the inventors of the present application: Mr. Hyoung Chan Rhee and Mr. Jong Su Hong. The assignee is Ringfree Co., Ltd. (hereinafter referred to as "Ringfree Company"), wherein Mr. Hyoung Chan Rhee is the president and representative director of Ringfree Company.

The assignment recorded on Reel 013739, Frame 0194 (hereinafter referred to as "the Subsequent Assignment") was recorded on February 12, 2003. The assignor and assignee in the Subsequent Assignment are Ringfree Co. and Ringfree International Corp. (hereinafter referred to as "Ringfree International"), respectively. Mr. Hyoung Chan Rhee, as an authorized officer of Ringfree Co., executed the subsequent assignment agreement on January 7, 2003.

05/18/2004 SDENBOB1 00000007 09763589

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130.00 OP

Applicants and Ringfree Company hereby assert that the subsequent assignment was fraudulently procured, is the subject of pending litigation in the Republic of Korea, and was a subject of litigation in the United States (Ringfree International Corporation v. Ringfree Company, Limited, et al., Case No. BC296018, Los Angeles County Superior Court). In the litigation case in California, Ringfree International sued Ringfree Company and Mr. Rhee for breach of contract based upon the subsequent assignment. This case was recently dismissed for improper venue and procedure.

Furthermore, Applicants assert that inventorship of the present application requires correction in that four additional inventors are to be added. Although documents necessary for inventorship correction under 37 C.F.R. § 1.48 have been prepared, a written consent by the current assignee, Ringfree International, under 37 C.F.R. § 3.73(b) would not be obtainable due to the pending litigation in Korea. Four affidavits supplied by the four additional inventors concerning inventorship are enclosed to provide evidentiary support for this assertion.

Accordingly, it is respectfully requested that this petition be granted and that the subsequent assignment be voided and nullified. If for any reason the Examiner finds this petition inadequately supported, the Examiner is requested to call the undersigned attorney at the Los Angeles, California, telephone number (213) 623-2221 to discuss the steps necessary for voiding the assignment recorded on Reel 013739, Frame 0194.

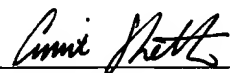
A fee for this petition under 37 C.F.R. § 1.17(h), in the amount of \$130, is enclosed. Should any additional fees be required or deficiencies in payment arise, please charge such fees or deficiencies to Deposit Account No. 502290.

Respectfully submitted,
Lee, Hong, Degerman, Kang & Schmadeka

Date: May 12, 2004

Customer No. 035884

Lee, Hong, Degerman, Kang & Schmadeka
801 South Figueroa Street, 14th Floor
Los Angeles, California 90017
Tel: (213) 623-2221
Fax: (213) 623-2211

By: 
Amit Sheth
Registration No. 50,176
Attorney for Applicant(s)



01-09-2003

Form PTO-1595
1-3-92E LETTER
YU.S. DEPARTMENT OF COMMERCE
Patent and Trademark Office

102332599

Attorney Docket No.: 2048-3-02

To the Assistant Commissioner for Patents: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):

Hyoungh Chan Rhee; Jong Su Hong

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

2. Name and address of receiving party(ies):

RINGFREE CO., LTD.
Dusan Bearstel 1308,
1319-11, Seocho-2-dong, Seocho-ku,
SEOUL, 137-040, REPUBLIC OF KOREA

3. Nature of conveyance:

- ☒ Assignment ☐ Merger
☐ Security Agreement ☐ Change of Name
☐ Other _____

Execution Date: December 8, 2002

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s): 09/763,589

If this document is being filed together with a new application, the execution date of the application is:

A. Patent Application No.(s) 09/763,589

B. Patent No.(s)

Additional numbers attached? ☐ Yes ☒ No

5. Name and address of party to whom correspondence concerning document should be mailed:

AMIT SHETH, Esq.
LEE & HONG P.C.
221 N. FIGUEROA STREET, 11TH Floor
LOS ANGELES, CALIFORNIA 90012

6. Total number of applications and patents involved: [1]

7. Total fee (37 CFR 3.41) \$40

- ☒ Enclosed
☐ Authorized to be charged to deposit account

8. Deposit account number: 502290

(Attach duplicate copy of this page if paying by deposit account)

DO NOT USE THIS SPACE

9. Statement and signature.

To the best of my knowledge and belief, the foregoing is true and correct and any attached copy is a true copy of the original document.

AMIT SHETH, REG. NO. 50,176

Date: December 30, 2002

OMB No. 0651-0011 (exp. 4/94)

Mail documents to be recorded with required cover sheet information to:

Assistant Commissioner for Patents
Box Assignments
Washington, D.C. 20231

01/09/2003 6TOM11 00000049 09763589

01 FC:0021

40.00 DP

PATENT
REEL: 013630 FRAME: 0426

ASSIGNMENT

Insert Name(s) of Inventor(s)

RHEE, HYOUNG CHAN HONG, JONG SU

In consideration of the sum of one dollar (\$1.00) and other good and valuable considerations paid to each of the undersigned, the undersigned agree(s) to assign, and hereby does assign, transfer and set over to

Insert name of Assignee

RINGFREE CO., LTD.

Insert state of Incorporation of Assignee

Republic of Korea

Insert address of Assignee

of
Dusan Bearstel 1308, 1319-11, Seocho-2-dong, Seocho-ku, Seoul 137-040, Korea
(hereinafter designated as the Assignee) the entire worldwide right, title and interest in the invention known as
METHOD AND DEVICE FOR GENERATING VOICE/TEXT/IMAGE COMMERCIAL
INFORMATION RINGBACK TONE DURING COMMUNICATION WAIT
(U.S. Patent Application No.: 09/763,589 filed on February 23, 2001)

Insert identification of Invention, such as Title, Case Number or Foreign Application Number

for which the undersigned has (have) executed an application for patent in the United States of America and all patent applications in foreign countries corresponding thereto or based thereon.

Insert Date of Signing of Application

February 22, 2001

1) The undersigned agree(s) to execute all papers necessary in connection with any original, reissue, divisional and continuing United States and foreign applications for the above-identified invention and also to execute separate assignments in connection with such applications as the Assignee may deem necessary or expedient.

2) The undersigned agree(s) to execute all papers necessary in connection with any interference which may be declared concerning this application or continuation or division thereof and to cooperate with the Assignee in every way possible in obtaining evidence and going forward with such interference.

3) The undersigned agree(s) to execute all papers and documents and perform any act which may be necessary in connection with claims or provisions of the International Convention for Protection of Industrial Property or similar agreements.

4) The undersigned agree(s) to perform all affirmative acts which may be necessary to obtain a grant of a valid United States patent to the Assignee.

5) The undersigned hereby authorize(s) and request(s) the Commissioner of Patents to issue any and all Letters Patents of the United States resulting from said application or any division or divisions or continuing applications thereof to the said Assignee, as Assignee of the entire interest, and hereby covenants that he has (they have) full right to convey the entire interest herein assigned, and that he has (they have) not executed any agreement in conflict herewith.
The undersigned hereby appoints JONATHAN Y. KANG, REG. NO. 38,199; RICHARD K. YOON, REG. NO. 42,247; EDWARD GRAY, REG. NO. 35,166; DAVID N. MAKOUS, REG. NO. 29,559; JOHN S. CHRISTOPHER, REG. NO. 30,937

the power to insert on this assignment any further identification which may be necessary or desirable in order to comply with the rules of the United States Patent and Trademark Office for recordation of this document.

Date: Dec. 06, 2002 Signature of Inventor

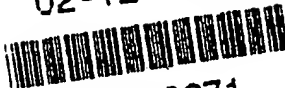
Date: Dec. 06, 2002 Signature of Inventor

Date: Signature of Inventor

Date: Signature of Inventor



02-12-2003



102363671

U.S. DEPARTMENT OF COMMERCE
U.S. Patent and Trademark OfficeForm PTO-1595
(Rev. 03/01)

OMB No. 0651-0027 (exp. 5/31/2002)

Tab settings

To the Honorable Commissioner of Patents and Trademarks: Please record the attached original documents or copy thereof.

1. Name of conveying party(ies):
RINGFREE COMPANY LTD.

2-10-03

2. Name and address of receiving party(ies)

Name: RINGFREE INTERNATIONAL CORPORATION

Internal Address: _____

RECEIVED

MAY 20 2004

Street Address: _____

Technology Center 2600

7110 Motz Street

City: Paramount State: CA Zip: 90723

Additional name(s) of conveying party(ies) attached? ☐ Yes ☒ No

3. Nature of conveyance:

☒ Assignment☐ Merger☐ Security Agreement☐ Change of Name☐ Other _____

Execution Date: 01/07/2003

Additional name(s) & address(es) attached? ☐ Yes ☒ No

4. Application number(s) or patent number(s):

If this document is being filed together with a new application, the execution date of the application is: _____

A. Patent Application No.(s) 09/763,589

B. Patent No.(s) _____

Additional numbers attached? ☐ Yes ☐ No

5. Name and address of party to whom correspondence concerning document should be mailed:

Name: Wen Liu

Internal Address: LIU & LIU

Street Address: _____

811 West 7th Street, Suite 1100

City: Los Angeles State: CA Zip: 90017

6. Total number of applications and patents involved: 1

7. Total fee (37 CFR 3.41).....\$ 40.00

☒ Enclosed☐ Authorized to be charged to deposit account

8. Deposit account number:

501288

DO NOT USE THIS SPACE

9. Signature.

WEN LIU

Name of Person Signing

Signature

February 3, 2003

Date

Total number of pages including cover sheet, attachments, and documents: 2

02/11/2003 LMUELLER 00000161 09763589

01 FC:8021

40.00 OP

Mail documents to be recorded with required cover sheet information to:
Commissioner of Patents & Trademarks, Box Assignments
Washington, D.C. 20231PATENT
REEL: 013739 FRAME: 0193

ASSIGNMENT

WHEREAS, Ringfree Company Ltd., a Korean corporation, (hereinafter "Assignor"), is the sole and exclusive owner, by assignment, of the United States Patent Application Serial No. 09/763,589, filed February 23, 2001, entitled "METHOD AND DEVICE FOR GENERATING VOICE/TEXT/IMAGE COMMERCIAL INFORMATION RINGBACK TONE DURING COMMUNICATION WAIT" (the "Patent Application"), and the inventions described therein; and

WHEREAS, Ringfree International Corporation, a corporation of California (hereinafter "Assignee"), is desirous of acquiring the entire worldwide right, title and interest in and to the inventions covered by said Patent Application.

NOW, THEREFORE, in consideration of and in exchange for the sum of One Dollar (\$1.00) to be paid by Assignee and other good and valuable consideration, the receipt of which is hereby acknowledged, Assignor has sold, assigned, and transferred, and does hereby sell, assign, and transfer the entire right, title and interest in and to the above-mentioned inventions, Patent Application, and any and all applications for Letters Patent in the United States of America and in all foreign countries (including but not limited to any and all priority patent applications filed in Korea and under the PCT), and in any and all Patents in the United States of America and all foreign countries which may be granted therefor and thereon, and in and to any and all divisions, continuations, and continuations-in-part of said application, or reissues or extensions of said Letters Patent or Patents, and all rights under the International Convention for the Protection of Industrial Property, the same to be held and enjoyed by the said Assignee, for its own use and the use of its successors, legal representatives and assigns, to the full end of the term or terms for which Letters Patent or Patents, may be granted, as fully and entirely as the same would have been held and enjoyed by the Assignor, had this sale and assignment not been made.

AND for the same consideration, Assignor hereby assigns to Assignee all of its rights to pursue any and all legal and equitable claims, causes of action, remedies and any other rights under the Patent Application and all Letter Patents in the United States of America and in any and all patent applications filed and Patents granted in all foreign countries, that may have accrued prior to the date of this assignment, including but not limited to any and all claims for patent infringement that may have occurred prior to the date of this assignment.

AND for the same consideration, Assignor hereby covenants and agrees to and with the Assignee, its successors, legal representatives and assigns, that, at the time of execution and delivery of these presents, the said Assignor is the sole and lawful owner of the entire right, title and interest in and to the said inventions and the Patent Application and any and all foreign patent applications above-mentioned and all existing and future related patent applications worldwide (including but not limited to obtaining in writing assignment of rights or obligation to assign to Assignor from all the inventors), and that the same are unencumbered and that the said Assignor has good and full right and lawful authority to sell and convey the same in the manner herein set forth.

AND Assignor hereby authorizes and requests the Commissioner of Patents and Trademarks to issue any and all Letters Patent or Patents of the United States on said inventions or resulting from said Patent Applications and any continuations, divisionals, reissues and reexamined patents related to the Patent Application to Assignee as Assignee of the entire interest, and hereby covenants that it has full right to convey the entire interest herein assigned, and that it has not executed, and will not execute, any agreements inconsistent herewith.

JAN 7, 2003
Date

Assignor

By Its Authorized Representative:

RHEE, HYUNG CHAN

Title: ~~PRESIDENT~~ REPRESENTATIVE DIRECTOR

AFFIDAVIT

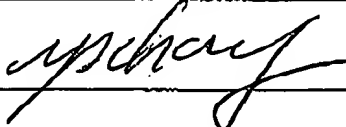
The people mentioned hereunder and undersigned, namely, Chang, Yun-Seok, Lee, Jung-Rye, Ha, Eun-Yong and Kim, Jae-Ho are the inventors of patent application No. 09/763,589 of the United States of America, and another right holders over the said patent application.

On the other hand, according to the transfer records of the U.S. Patent and Trademark Office, the said U.S. patent application 09/763,589 was transferred from RINGFREE Co., Ltd.(Korea) to RINGFREE-INTERNATIONAL Corp. on February 10, 2003 (date of recording), but since this transfer was made without any agreement and signing of the undersigned inventors upon the transfer, it is gravely disqualified.

Thus, we hereby request that the transfer record of the U.S. Patent and Trademark Office on the said February 10, 2003 be deleted and abolished in accordance with the inventors' statement.

For reference, the inventors mentioned hereunder are those who are recorded as inventors on the documents of Korea's patent application No. 1999-29153, No. 1999-33113, and No. 1999-41268, and we herewith attach as an evidence the transcript of the translation of the priority submitted to the U.S. Patent and Trademark Office.

April. 26. 2004

Date	Inventors	Signature
2004 / 04 / 26	Chang, Yun Seok	

AFFIDAVIT


The people mentioned hereunder and undersigned, namely, Chang, Yun-Seok, Lee, Jung-Rye, Ha, Eun-Yong and Kim, Jae-Ho are the inventors of patent application No. 09/763,589 of the United States of America, and another right holders over the said patent application.

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April. 26. 2004

Date	Inventors	Signature
26/04/2004	Kim Jae-Ho	

AFFIDAVIT

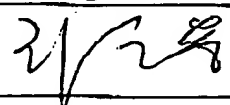
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April 26, 2004

Date	Inventors	Signature
April. 26. 2004	Ha, Eun-Yong	

AFFIDAVIT

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April. 26. 2004

Date	Inventors	Signature
April. 26. 2004	Lee, Jung-Rye	Jung Rye Lee